

REMARKS/ARGUMENTS

Claims 1-94 were pending in the subject application. Applicant has hereinabove canceled claims 1-2, 8-10, 15-23, 32-40, 43-62, 66-70, 72, 79-90 and 92-94; amended claims 3-7, 11-14, 24-31, 41-42, 63-65, 71, 78 and 91; and added new claim 95. Accordingly, upon entry of this Amendment claims 3-7, 11-14, 24-31, 41-42, 63-65, 71, 73-78, 91 and 95 will be pending and under examination.

Applicant maintains that these amendments to claims 3-7, 11-14, 41-42, 63-65, 71, 78 and 91; and new claim 95, do not raise any issue of new matter, and that these claims are supported by the specification as originally filed.

1. Rejection Under 35 U.S.C. §112, First Paragraph, Written Description

In the September 11, 2006 Office Action, the Examiner rejected claims 33-65 and 94 under 35 U.S.C. §112, first paragraph, written description, as allegedly failing to comply with the written description requirement. The Examiner alleged that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, has possession of the claimed invention. Specifically, the Examiner alleged that the specification fails to support the limitations "at least one projection" as claimed in claim 33 and "said projection" as claimed in claim 49. The Examiner alleged that the remaining claims are dependent upon the above rejected based claim and thus inherit the deficiency thereof.

RESPONSE

In response, applicants have canceled claim 33-40, 43-62 and 94, rendering the rejection thereof moot; and amended claims 41-42 and 63-65 to depend on new claim 95. Amended claims 41-42 and 63-65 do not recite the elements "at least one projection" or "said projection".

In view of the applicant's amendments to the claims, applicant respectfully requests the Examiner to remove this ground of rejection.

2. Rejection Under 35 U.S.C. §112, Second Paragraph, Indefiniteness

In the September 11, 2006 Office Action, the Examiner rejected claims 33-67 and 92-94 under 35 U.S.C. §112, second paragraph, indefiniteness, as allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner alleged that the feature "at least one projection" renders the claims unclear because lacking of the function and the location relative to other elements of the eyeglass device. The Examiner further alleged that the limitations "said auxiliary clip-on possess a rearwardly concave arcuate shape" in claim 38 is redundant. The Examiner also alleged that the phrase "said torsion bar" in claim 42, the phrase "said outer sides" in claim 46, the phrase "said outer side" in claim 47 and 48, the phrase "said upper side" in claim 49, the phrase "said second end piece" in claim 66, the phrase "said auxiliary clip-on assembly" in claim 67, the phrase "the primary spectacle frame" in claim 92 and the phrase "said auxiliary clip-on assembly frame" in claim 94 all have no antecedent basis. The Examiner alleged that the remaining claims are dependent upon the above rejected based claim and thus inherit the deficiency thereof.

RESPONSE

In response, applicants have canceled all rejected claims except for claims 41-42 and 63-65, which have been amended to depend on new claim 95. Amended claims 41-42 and 63-65 have an antecedent basis for all claimed elements in new claim 95.

In view of the applicant's amendments to the claims, applicant respectfully requests the Examiner to remove this ground of rejection.

3. Rejection Under 35 U.S.C. §102(b)

The Examiner rejected claims 1, 2, and 5 under 35 U.S.C. §102(b) as being anticipated by Xiao (U.S. Patent 6,505, 932) (“Xiao”) and also that the limitations in these claims are shown in Xiao’s Figure 1, columns 3-4.

RESPONSE

In response, applicant has canceled claim 1, rendering the rejection thereof moot; and amended claims 2 and 5 to depend on new claim 95.

Under MPEP 2131, a claim is anticipated only if each and every element as set forth in the claim is found in a single prior art reference. Xiao does not teach every element of amended claims 2 and 5.

In view of the applicant's amendments to the claims, applicant respectfully requests the Examiner to remove this ground of rejection.

4. Rejection Under 35 U.S.C §102(b)

The Examiner rejected claims 8-13, 20, 23, 26, 27, 30, and 32 under 35 U.S.C. §102(b) as being anticipated by Martin (U.S. Patent No. 5,867,244) (“Martin”), and also that the limitations in these claims are shown in Martin’s Figs. 1,2.

RESPONSE

In response, applicant has canceled claims 8-10, 20, 23 and 32, rendering the rejection thereof moot; and amended claims 26, 27 and 30 to depend on new claim 95.

As noted above, under MPEP 2131, a claim is anticipated only if each and every element as set forth in the claim is found in a single prior art reference. Martin does not teach every element amended claims 26, 27 and 30.

In view of the applicant's amendments to the claims, applicant respectfully requests the Examiner to remove this ground of rejection.

5. Rejection Under 35 U.S.C §102(b)

The Examiner rejected claims 8, 15, and 16 under 35 U.S.C. §102(b) as being anticipated by Sadler (U.S. Patent No. 5,416,537) ("Sadler"), and also that the limitations in these claims are shown in Sadler's Figs. 1-3.

RESPONSE

In response, applicant has canceled claims 8, 15 and 16 rendering this rejection moot.

In view of the applicant's amendments to the claims, applicant respectfully requests the Examiner to remove this ground of rejection.

6. Rejection Under 35 U.S.C §102(b)

The Examiner rejected claims 33-40, 43-65 and 94 under 35 U.S.C. §102(b) as being anticipated by Lee (U.S. App. 2001/0021001) ("Lee"), and also that the limitations in these claims are shown in Lee's Figs. 1, 2, 6-8 (pages 2-3).

RESPONSE

In response, applicant has canceled claims 33-40, 43-62 and 94 rendering the rejection thereof moot; and amended claims 63-65 to depend on new claim 95.

Under MPEP 2131, a claim is anticipated only if each and every element as set forth in the claim is found in a single prior art reference. Lee does not teach every element of amended claims 41-42 and 63-65.

In view of the applicant's amendments to the claims, applicant respectfully requests the Examiner to remove this ground of rejection.

7. Rejection Under 35 U.S.C §102(b)

The Examiner rejected claims 33, 34, 41, and 42 under 35 U.S.C. §102(b) as being anticipated by Huang (U.S. Patent No. 6,113,234) ("Huang").

RESPONSE

In response, applicant has canceled claims 33 and 34 rendering the rejection thereof moot; and amended claims 41 and 42 to depend on new claim 95.

Under MPEP 2131, a claim is anticipated only if each and every element as set forth in the claim is found in a single prior art reference. Huang does not teach every element of amended claims 41 and 42.

In view of the applicant's amendments to the claims, applicant respectfully requests the Examiner to remove this ground of rejection.

8. Rejection Under 35 U.S.C §102(b)

The Examiner rejected claim 71 under 35 U.S.C. §102(b) as being anticipated by Lemelson (U.S. Patent No. 4,217,037).

RESPONSE

In response, applicant has amended claim 71 to incorporate the limitations of claim 72.

Under MPEP 2131, a claim is anticipated only if each and every element as set forth in the claim is found in a single prior art reference. Claim 71 contains all the limitations of claim 72, which,

as acknowledged by the Examiner in the September 11, 2006 Office Action, contained allowable subject matter if re-written in independent form. Accordingly, the Examiner has acknowledged that Lemelson does not teach every element of the amended claim 71.

In view of the applicant's amendments to the claims, applicant respectfully requests the Examiner to remove this ground of rejection.

9. Rejection Under 35 U.S.C §102(e)

The Examiner rejected claims 79-91 under 35 U.S.C. §102(e) as being anticipated by Ifergan (U.S. Patent No. 6,811,254).

RESPONSE

In response, applicant has canceled claims 79-90 rendering the rejection thereof moot; and amended claim 91 to depend on new claim 95.

Under MPEP 2131, a claim is anticipated only if each and every element as set forth in the claim is found in a single prior art reference. Ifergan does not teach every element of amended claim 91.

In view of the applicant's amendments to the claims, applicant respectfully requests the Examiner to remove this ground of rejection.

10. Rejection Under 35 U.S.C §102(b)

The Examiner rejected claims 92 and 93 under 35 U.S.C. §102(b) as being anticipated by Xiao.

RESPONSE

In response, applicant has canceled claims 92 and 93 rendering the rejection thereof moot.

In view of the applicant's amendments to the claims, applicant respectfully requests the Examiner to remove this ground of rejection.

11. Rejection Under 35 U.S.C §103(a)

The Examiner rejected claims 3, 4, 6, and 7 under 35 U.S.C. 103(a) as being unpatentable over Xiao.

RESPONSE

In response, applicant has amended claims 3, 4, 6 and 7 to depend on new claim 95.

Under MPEP §2143, to establish a prima facie case of obviousness the cited references must teach or suggest every element of the claims. Xiao does not teach every element of amended claims 3, 4, 6 and 7.

In view of the applicant's amendments to the claims, applicant respectfully requests the Examiner to remove this ground of rejection.

12. Rejection Under 35 U.S.C §103(a)

The Examiner rejected claims 14, 21, 22, 24, 25, 28, 29, 31 under 35 U.S.C. 103(a) as being unpatentable over Martin.

RESPONSE

In response, applicant has canceled claims 21, 22 and 35 rendering the rejection thereof moot; and amended claims 14, 24, 25, 28, 29 and 31 to depend on new claim 95.

Under MPEP §2143, to establish a prima facie case of obviousness the cited references must teach or suggest every element of the claims. Martin does not teach every element of amended claims 14, 24, 25, 28, 29 and 31.

In view of the applicant's amendments to the claims, applicant respectfully requests the Examiner to remove this ground of rejection.

13. Rejection Under 35 U.S.C §103(a)

The Examiner rejected claims 17-19 under 35 U.S.C. 103(a) as being unpatentable over Sadler.

RESPONSE

In response, applicant has canceled claims 17-19 rendering the rejection thereof moot.

In view of the applicant's amendments to the claims, applicant respectfully requests the Examiner to remove this ground of rejection.

14. Rejection Under 35 U.S.C §103(a)

The Examiner rejected claims 66-70 under 35 U.S.C. 103(a) as being unpatentable over Huang.

RESPONSE

In response, applicant has canceled claims 66-70 rendering the rejection thereof moot.

In view of the applicant's amendments to the claims, applicant respectfully requests the Examiner to remove this ground of rejection.

15. Rejection Under 35 U.S.C §103(a)

The Examiner rejected claim 78 under 35 U.S.C. 103(a) as being unpatentable over Lemelson.

RESPONSE

In response, applicant has amended claim 78 to depend on new claim 95.

Under MPEP §2143, to establish a prima facie case of obviousness the cited references must teach or suggest every element of the claims. Lemelson does not teach every element of amended claim 78.

In view of the applicant's amendments to the claims, applicant respectfully requests the Examiner to remove this ground of rejection.

Allowable Subject Matter

The Examiner has indicated that claims 72 would be allowable if re-written in independent form including all the limitations of the base claim and any intervening claims. In addition, the Examiner has indicated that claims 73-77 are objected to as being dependent upon the objected claim 72.

RESPONSE

In response, Applicant has rewritten claim 71 to incorporate all the limitations of claim 72. Claims 73 has been amended to depend on amended claim 71. Accordingly, applicant respectfully requests allowance of claims 71 and 73-77.

CONCLUSION

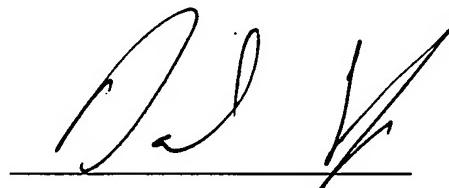
Reconsideration and further examination is respectfully requested.

Reply to Office action of December 09, 2005

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicant's undersigned attorney invites the Examiner to contact them at the number provided below.

No fee, other than the \$60.00 fee for a one-month extension of time, is deemed necessary in connection with the filing of this Amendment. If any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account 12-0115.

Respectfully submitted,

A handwritten signature consisting of two parts. The first part, on the left, appears to be "G.E." followed by a stylized surname. The second part, on the right, appears to be "D.N." followed by a stylized surname. Both signatures are written in black ink on a white background.

Gary E. Lambert
Registration No. 35,925
Daniel N. Smith
Registration No. 56,445
Lambert & Associates
92 State Street
Boston, MA 02109



Appl. No. 10/769,238
Reply to Office action of December 09, 2005

CERTIFICATE OF MAILING

I hereby certify that this Amendment is being deposited with the United States Postal Service in an envelope addressed to the Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 with sufficient first class postage thereon on the date shown below.

Date: 1/11/2007



Daniel N. Smith